

REMARKS

Claims 14-17 are pending in this application and stand rejected under 35 U.S.C. § 103(a). The Examiner has made the rejection of these claims final. Applicants respectfully traverse and request that the Examiner reconsider the final rejections. In view of the following remarks, the Applicants respectfully submit that the claims 14-17 are in condition for allowance.

Claim Rejections – 35 U.S.C. § 103(a)

Pending claims 14-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable based on Cross (U.S. Patent No. 6,144,726) in view of the Examiner's Official Notice. Claim 17 stands rejected under § 103(a) as being unpatentable over Cross in view of the Official Notice and Barich (U.S. Patent No. 6,955,100).

Claims 14-17 are directed to methods of verifying repair facility charges billed to an equipment owner by a repair agent. The claimed systems provide solutions to the problems faced by equipment owners and repair agents in verifying charges for repairs of equipment, such as railcars. For example, claims 14-17 each require facilitating repair agent review of and response to the billing exception records via the billing verifications system. The claims also require generating a billing exception response record for one or more repair agent responses and notifying the equipment owner of the repair agent responses.

As the Examiner acknowledges, Cross does not teach or suggest these features of claims 14-17. The Examiner relies upon Official Notice that “facilitating review and response to records via system, generating record for one or more responses and notify owner of responses is old and well known in the banking industry as a convenient way for business or service person to provide individual customer accurate or up-to-date information.” Office Action at 3. Although the Official Notice formed a new basis for rejection of claims 14-17, the Examiner asserted that “Applicants’ amendment necessitated the new ground(s) of rejection.” *Id.* at 5. The Applicants’ amendment did not necessitate the Official Notice, and the final rejection is premature.

Applicants’ amendment corrected a typographical error by substituting two words in the final limitation of claim 14 (replacing “customer” with “equipment owner”). The error in the original claim was apparent because there was no antecedent basis for the

word “customer” in this limitation. Applicants corrected the error by replacing “customer” with “equipment owner,” for which antecedent basis is recited in the preamble. This amendment to correct this typographical error did not affect the scope of the claim and therefore did not necessitate the Examiner’s new rejection under § 103(a) based on the Official Notice.

Moreover, the Examiner relies on the Official Notice for alleged teaching of not just the amended final limitation, but also of *two other limitations*, which Applicants did not amend. Applicants note that circumstances supporting official notice should be rare when an application is under final rejection. MPEP 2144.03. The circumstances here do not support a final rejection based on the Official Notice. For these additional reasons, the final rejection is premature. Applicants respectfully request that the Examiner reconsider the final rejection.

Applicants also request support for the Examiner’s Official Notice. Official notice without documentary evidence to support a rejection is permissible only when “the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.” MPEP 2144.03 (citing *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970); *see also* 37 CFR § 1.104(d)). The features noted in the Examiner’s Official Notice were neither old nor well-known. There is nothing in the documentary record to demonstrate that these features were old or well-known, and the Examiner has not provided any evidence in support of the Official Notice. The facts asserted in the Official Notice certainly are not “capable of *instant and unquestionable* demonstration as being well-known.” *Id.* Moreover, the Examiner asserts that these features were well-known in the banking industry, but fails to explain why one of ordinary skill in the art would have consulted the banking industry when developing a method for verifying repair facility charges billed to an equipment owner by a repair agent. Because this Official Notice asserts facts that are not well known, Applicants respectfully request an affidavit from the Examiner to support this rejection of claims 14-17. (*See* MPEP 2144.03 and 37 CFR 1.104(d)(2).)

As noted above, this application does not present the rare circumstances that support official notice under final rejection. Accordingly, if the Examiner provides an affidavit or other new evidence in support of the Official Notice, any rejection should be non-final so that Applicants may have an opportunity to respond to the new evidence.

Summary

In view of the foregoing remarks, Applicants respectfully request that the Examiner reconsider the final rejection. Applicants submit that all of the pending claims are in condition for allowance and seek early allowance thereof. If, for any reason, the Examiner is unable to allow the application in the next Office Action, Applicants request that the Examiner provide an affidavit supporting any Official Notice that forms the basis for a rejection. If the Examiner believes that an interview would be helpful to resolve any remaining issues, she is respectfully requested to contact the attorney on record, Charles M. McMahon, at (312) 321-4782.

Respectfully submitted,

/s/ Charles M. McMahon

Charles M. McMahon
Registration No. 44,926
Attorney for Applicants

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200